

REMARKS

Claims 1-30 are all the claims presently pending in the application. Claims 20-30 have been canceled without prejudice or disclaimer. Claims 4, 9, 12, 14, 16, 18 and 19 have been merely editorially amended and have not been substantively amended to more particularly define the invention.

Entry of this Amendment is believed proper since no new issues are being presented to the Examiner that would require further consideration and/or search.

Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-19 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Claims 1-19 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

These rejections are respectfully traversed in the following discussion.

I. THE 35 USC §112, FIRST PARAGRAPH REJECTION

The Examiner alleges that claimed invention of claims 1-19 was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and use the invention. The Examiner, however, is clearly incorrect.

Applicants maintain the traversal arguments included in the Amendment filed on December 7, 2006, the substance of which is incorporated herein by reference.

Applicants again submit that the test for enablement is “whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention.” (See M.P.E.P. § 2164.01; emphasis added by Applicants).

Applicants maintain that the above standard for the enablement requirement has been met.

The Examiner's rejection relies mainly on the assertions that Applicants' disclosure is allegedly "hypothetical" and does not provide "examples" of the synthesis of the claimed molecular manipulator.

Applicants again point out, however, that "[c]ompliance with the enablement requirement of 35 U.S.C. 112, first paragraph, does not turn on whether an example is disclosed. An example may be 'working' or '**prophetic**'. A prophetic example describes an embodiment of the invention based on predicted results rather than work actually conducted or results actually achieved. An applicant need not have actually reduced the invention to practice prior to filing" (see M.P.E.P. § 2164.02; emphasis add by Applicants). Therefore, Applicants submit that the examples provided in Figures 1 and 2 of the Application are sufficient for purposes of providing an enabling disclosure of the claimed invention.

Furthermore, with respect to the Examiner's allegations that the experimentation required by one of ordinary skill in the art would have been "undue", Applicants submit that "[t]ime and difficulty of experiments are not determinative if they are merely routine." (See M.P.E.P. § 2164.06; emphasis added by Applicants). Applicants submit that the experimentation required by one skilled in the related art to make and use the claimed invention is clearly routine (as is illustrated in the documents submitted in the Information Disclosure Statement filed on August 19, 2003).

Moreover, Applicants submit that since the level of skill in the related art is high, the degree of experimentation that is considered routines is also high.

Applicants submit that the amount of experimentation required to make and use the claimed invention is commensurate with the level of skill in the related art.

Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

II. THE 35 USC §112, SECOND PARAGRAPH REJECTION

The Examiner alleges that the claimed invention of claims 1-19 is indefinite for allegedly failing to particularly point out and distinctly claim the subject matter of the claimed invention.

With respect to claims 4, 9, 12, 14, 16, 18 and 19, Applicants submit that it is unnecessary to amend the claims as the language recited in these claims is clearly definite. However, merely in an effort to speed prosecution, Applicants have amended claims 4, 9, 12, 14, 16, 18 and 19 as suggested by the Examiner.

The Examiner, with respect to claim 1, alleges that the term “probe” is indefinite. Applicants submit, however, that when considering whether a term is indefinite the Examiner must consider the claim language in view of the teachings of the specification. The term probe is clearly defined in the specification at page 11, lines 4-18.

Similarly, with respect to claim 2, the term “line”, as recited in the claimed invention, is clearly defined in the Specification.

The Examiner is reminded that”

“A fundamental principal is that applicants can be their own lexicographers. Applicants may define their invention, in the claims, essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. A claim may not be rejected solely because of the type of language used to define the claimed invention.” (See M.P.E.P. § 2173.01; emphasis added by Applicants).

With respect to claim 5, Applicants again point out when considering whether a term is indefinite the Examiner must consider the claim language in view of the teachings of the specification. This feature is clearly illustrated in Figures 1 and 2 of the Application. Furthermore, the claim clearly recites “a moiety located between the two arms”. Applicants cannot understand how this limitation is not understood.

With respect to claim 6, the language of the claim clearly defines that the bond of the second arm includes any bond other than an “azo double bond”. Applicants point out that this has previously been explained to the Examiner.

With respect to claim 10, Applicants point out that this claim was previously amended to recite “the same”. The Examiner is urged to review the Amendment filed on December 7, 2006, in which the amendment to claim 10 was made.

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

Applicants again point out that in accordance with the Examination Guidelines set forth in the M.P.E.P., a patent application should not be examined in a “piecemeal” manner. That is, the patent application must be evaluated under 35 U.S.C. §§101, 112, 102 and 103 at the same time.

Therefore, since the Examiner has not included any prior art rejections, Applicants have assumed that, in accordance with M.P.E.P. Examination Guidelines, the Examiner has conducted a thorough search of the existing related art and has not found any related art references that teach or suggest the claimed invention.

Therefore, if Applicants overcome the current rejections under 35 U.S.C. §112, first and second paragraphs, Applicants assume that the Application will be in condition for allowance.

In response to Examiner's objections to the specification, Applicants request the Examiner to refer to the arguments provide above in Section I.


In view of the foregoing, Applicant submits that claims 1-19, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: March 19, 2007



Scott M. Tulino, Esq.
Registration No. 48,317

Sean M. McGinn, Esq.
Registration No. 34,386

**MCGINN INTELLECTUAL PROPERTY
LAW GROUP, PLLC**
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254